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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/453,729 | 12/02/99 | ROGERS | D 1368 (TOUCHST |

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IM52/0827

EXAMINER

MEDLEY, M

| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

89/453 129

Applicant(s)

ROGERS

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/23/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1714

DETAILED ACTION

In the interest of compact prosecution the requested amendment to page 1 at lines 9, 10 and 11 could not be found, but were found at page 3 lines 9, 10 and 11 and was entered at said location. Applicants are required to clarify the record as to the proper location of the requested amendment.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 9 line 3 the limitation "inconel", titanium, refractory metals" was not properly described in the application as filed, and consequently raise doubt as to possession of the claimed invention at the time of filing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1714

Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is indefinite for "said material is paper" which has not been set forth in claim 12. Claim 10 is indefinite for "said sheet core has been carbonized" which has not been set forth in claim 12. Claim 11 is indefinite for "said sheet core is graphitized" which has not been set forth in claim 12. In the interest of compact prosecution claims 9-12 will be treated on the merits as claim 12 comprising facing materials. Clarification to the record is requested for claim 12 limitations.

Claim 9 recites the limitation "said material is paper" in lines 1-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "said sheet core has been carbonized" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said sheet core in graphitized" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1714

Claims 1-4 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Harnett 3,309,437.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 in view of Koppelman 4,127,391 for reasons made of record in Paper No. 2 dated October 5, 2000.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 in view of Kuroda JP-0811287619A.

Harnett teaches a porous based product having comprehensive strength typically in excess of 5,000 psi (note page 4 lines 1-9) when heated to 950°C and an apparent density of 0.93 g/cc (note Table 1 for examples 4 and 5) and further graphitizing (note column 5 lines 20-44). Patentee's apparent density of between about 0.1 and about 0.8 g/cm³ is anticipated by because about 0.8 g/cm³ reads on 0.93 g/cc. Patentee also teaches that formed bodies are used for insulating blocks for furnaces and reactors, filters, etc. (Note column 3 lines 12-22) and that the core products are formed inside containers made of graphite, stainless steel or cardboard (note column 2 lines 4-11).

Art Unit: 1714

Applicants instant claims require the core to be laminated sheet product wherein Harnett is silent to the said laminated products being sheet products. It is the examiner's position that it would be obvious to the artisan in the art to use a core between laminated sheets in view of JP '876.

The JP '876 references teach laminated sheets comprising a core of charcoal powder (graphitized coal product) and activated carbon powder (carbonized and coal product) note the English abstract and Figures 1-3. It would be obvious to the artisan in the art to use the laminated sheet with a core of the JP '876 patent as the laminated sheet with the core of Harnett because the cores and sheets of JP '876 are of the same nature as the core and container of Harnett to be used for the same intended purposes as laminated products for walls, etc.

Applicant's arguments filed May 23, 2001 have been fully considered but they are not persuasive.

Applicant has asked the Examiner for clarification of the Examiner's statement at page 2 of the Office action Paper No. 2 datd October 5, 2000, that "In each of claims 1-11 (and now added claim 12) the parenthesis")" following each claim should be deleted and a period "." should be use in place thereof. For example In claim 1, delete "(1)" and insert in place thereof -- Claim1---1., delete "(2)" and insert in place thereof ---Claim 2---. Following the numbering of each claim a period "." should be used, not a parentheses ")".

Art Unit: 1714

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., under these conditions and with coke particles, no foaming takes place, although some mass loss may occur, the results is an at least partially sintered coke body and although the body may exhibit some degree of porosity, it is not a foam by any conventional definition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the coal starting materials of the instant application typically comprises greater than about 30% volatiles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that , the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art Harnett examples 4 and 5 of Table 1 found in column having an apparent density of 0.93 g/cc would not be equate to the claimed upper range density of 0.8 g/cc by one skilled in the art. cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 1714

The examiner maintains the position stated of record that a range having a density of between about 0.1 and about 0.8 g/cc is anticipated by the claimed apparent density of 0.93 g/cc because about 0.8 g/cc anticipates the value point density of 0.93 g/cc. Further a careful review of the instant application and experimental data of record is absence of any showing to the contrary.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Koppelman does not adds to the disclosure of Harnett since Kappelman make no attempt to produce a controlled foam, changes the chemical composition of the coal in the autoclave process and indicates the finished product is a solid fuel and not a foam as described and claimed by applicants) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 1714

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518

Margaret B. Medley /nh

August 24, 2001


MARGARET MEDLEY
PRIMARY EXAMINER